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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Herman KUENZER et al.

Examiner: S. Qazi

Serial No.: 09/497,891

Group Art Unit: 1616

Filed: February 4, 2000

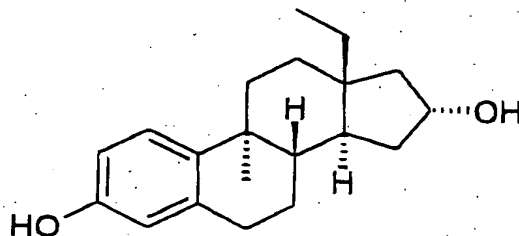
Title: 16-HYDROXYESTRATRIENES AS SELECTIVELY ACTIVE ESTROGENS

RESPONSE TO REQUIREMENT FOR RESTRICTION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed July 5, 2001, and the restriction requirement set forth therein, Applicants hereby elect a Group of invention exemplified by the compound of the following formula:



This compound does not fall within any of the Groups recited in the restriction requirement. This compound contains no double bonds in any of the B, C or D rings. Apparently, the restriction was made based on a misinterpretation of the claims because the double bonds in rings B, C and/or D are clearly stated as only being optional. In the elected compound, there are no such double bonds. The election is made with traverse for the reasons set forth below.

Applicants reserve the right to file one or more divisional applications directed to the non-elected subject matter.

The restriction between the various types of compounds is traversed on the basis that this should be an Election of Species scenario under Markush practice rather than a restriction requirement. Claim 1 is a proper Markush group. A Markush claim **can** contain independent and distinct inventions such that a prior art reference anticipating the claim with respect to one member would not render the claim obvious with respect to another member. The PTO's own rules on this matter set forth in M.P.E.P. §803.02 specifically state that:

"A Markush-type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. §103 with respect to the other member(s)."

This section of the M.P.E.P. makes clear that such a claim is a proper Markush claim and should be examined in accordance with Markush practice. Applicants request that, should this restriction be maintained, authority be cited as to why this section of the M.P.E.P. is not applicable.

Furthermore, M.P.E.P. §2173.05(h) discusses types of improper Markush claims and applicants' claims are not of the type indicated to be improper therein. All compounds encompassed by instant claim 1 have a common structural core of the general formula I and exhibit a community of properties as discussed, for example, at pages 39-40, of the disclosure, for example. Thus, claim 1 meets the requirement for a proper Markush claim.

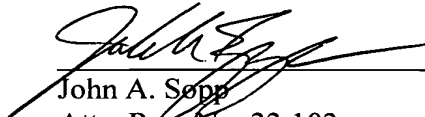
Accordingly, it is respectfully submitted that the instant claims are proper Markush claims. Therefore, the restriction among groups of the compounds is not proper and should be withdrawn.

Additionally, the restriction of the method claims from the compound/composition claims is also not supported. The method claims recite the same compounds of the compound/composition claims and applicants are entitled to inclusion of a method with the compound/compositions. Thus, the restriction of the method claims should also be withdrawn.

Favorable action is earnestly solicited.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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Attorney Docket No.: **SCH-1692**

Date: October 5, 2001